

REMARKS

Claims 1, 2 and 6 have been amended, and claims 7 and 8 have been added, leaving claims 1-8 in the case and at issue.

The present invention relates to a new and improved modular propeller used on boats that allow the individual blades to be replaced and to a counter rotating propeller system.

Applicant is pleased to note that the Examiner stated that claim 1 would be allowable "if rewritten or amended to overcome the rejection under 35 USC 112, 2nd paragraph," and that claims 2-5 would be allowable "if rewritten to overcome the rejection under 35 USC 112, 2nd paragraph" and "to include all of the limitations of the base claim and any intervening claims." Applicant appreciates the exactness with which the Examiner looked at these claims. By this Amendment A claim 1 is no longer indefinite and the informality in claim 2 has been corrected.

Claim 1 was rejected under 35 USC 112, 2nd paragraph, due to the word "solid," which has been removed. In claim 2, -- extending -- has been inserted after "bore," as recommended by the Examiner. Thus, claim 1 and dependent claims 2-5 are now deemed in condition for allowance.

New claim 7 includes the general limitations of the hub of claim 1 in a modular counter rotating propeller system having a front center hub and a rear center hub rotating counter to one another. New claim 8 is dependent on new claim 7 and specifies that the cores of the two hubs are aluminum. Thus, new claims 7 and 8 are also deemed in condition for allowance.

Claim 6 was rejected under 35 USC 112, 2nd paragraph, due to the last three lines of the claim ~~was~~ ^{which} the Examiner characterized as inaccurate. Applicant has clarified this by adding "free stream" before "water" and "until exiting the propeller system" at the end of the claim. "Free stream" is a well known hydrodynamic term which is used to describe the water that the boat is moving

through. As seen in Figures 4A and 4B, the exhaust gases are conducted through the outlet nozzle 442 and will mix with the free stream water that contacts and is driven by the first set of propeller blades 418-420 and the second set of propeller blades 430-432 only downstream of the nozzle. No new matter has been added by this clarification.

Turning now to the prior art, claim 6 was rejected as being unpatentable over Rodskier in view of applicant's earlier patent. Applicant respectfully submits that amended claim 6 is not obvious in view of the two cited references.

The Examiner is correct in the last paragraph on page 4 of the Office action when he lists all of the aspects of claim 6 that Rodskier does not disclose. While Rodskier is certainly analogous art, it must be considered as a whole. One is not permitted within the framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. Bausch & Lomb, Inc. v Barnes-Hind/Hydrocurve, 796 F.2d 443, 448 (Fed. Cir. 1986), cert. denied, 484 U.S. 823 (1987).

Before prior art references can be combined or modified, there must be some suggestion or motivation found in the art to make the combination or modification. "It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements." Arkie Lures, Inc. v. Gene Larew Tackle, Inc., 119 F.3d 953, 957 (Fed. Cir. 1997).

The fact that references can be modified or combined is insufficient to meet this criterion. Moreover, the fact that the modification or combination would be well within the ordinary skill in the art, by itself, is insufficient to meet this criterion. You as the Examiner need to show the

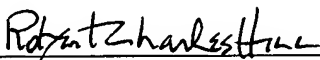
additional step of how this knowledge of the skilled artisan leads to the suggestion or motivation. Mere conclusionary statements do not adequately address the issue of motivation to combine.

By relying on the combination of Rodskier in view of Stahl the Examiner has recognized that there is no structure in the prior art like the present invention. The motivation to combine these 2 references in any manner is not present in the text of the references even though Stahl issued some 5 years before Rodskier, because Rodskier does not teach anything about replaceable blades.

It is respectfully submitted that applicant has successfully addressed each of the concerns raised by the Examiner. Early allowance of claims 1-8 and passage of the application to issuance are earnestly solicited. Should the Examiner be of the opinion that a telephone conference with applicant's attorney would expedite matters, he is cordially invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Dated: October 12, 2005



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